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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,054	07/31/2006	Isidor Hazan	FA1165 US PCT	4350

7590 02/27/2009
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EXAMINER

FRANK, NOAH S

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,054	Applicant(s) HAZAN, ISIDOR	
	Examiner NOAH FRANK	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/10/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "low molecular weight" in claims 1 and 12 is a relative term which renders the claim indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 1 and 12 recite the broad recitation “silane functional compound with a hydrolysable group on the silane group”, and the claim also recites “and preferably at least one additional functional group” which is the narrower statement of the range/limitation.

In the present instance, claims 1 and 12 recite the broad recitation “silane functional compound with a hydrolysable group on the silane group”, and the claim also recites “(urea, urethane and/or hydroxyl)” which is the narrower statement of the range/limitation. Additionally, it is not clear whether the functional groups in parentheses (urea, urethane and/or hydroxyl) are required or exemplary.

In the present instance, claim 13 recites the broad recitation “molded SMC and other plastic parts”, and the claim also recites “particularly auto parts” which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 5-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hazan et al. (WO 2004/014991).

Considering Claims 1-2, 12: Hazan et al. teaches the claimed invention with all of the claimed components except for the blocked polyisocyanate crosslinking agent

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(Claim 1). However, since the blocked polyisocyanate crosslinking agent is not a required component, Hazan anticipates the claimed invention.

Considering Claim 5: Hazan et al. teaches the composition comprising a conductive pigment (Claim 2).

Considering Claim 6: Hazan et al. teaches the composition wherein the silane functional oligomer is a urethane or urea (Claim 4).

Considering Claim 7: Hazan et al. teaches the composition wherein the oligomer is formed according to the claimed method (Claim 5).

Considering Claim 8: Hazan et al. teaches the composition wherein the silane functional oligomer has a weight average molecular weight from 500 to 3000 (Claim 6).

Considering Claim 9: Hazan et al. teaches the composition wherein the binder further comprises 0 to 10% of dispersed particles with a urea, urethane, silane, or hydroxyl group (Claim 7).

Considering Claim 10: Hazan et al. teaches the composition further comprising an orthoacetate ester water scavenger (Claim 8).

Considering Claim 11: Hazan et al. teaches the composition is at least 50% by weight binder solids (Claim 9).

Considering Claims 13-16: Hazan et al. teaches a method of sealing a SMC substrate comprising applying a layer of the coating onto an SMC substrate and curing the layer into a sealed coating (Claim 10). Hazan also teaches a plastic substrate coated with a layer of the coating composition (Claim 11), the substrate being a

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thermoset reinforced plastic article (Claim 12), and the substrate being a molded SMC auto body panel (Claim 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazan et al. (WO 2004/014991), as applied to claim 1 above.

Considering Claim 3: Hazan et al. teaches the basic claimed composition as set forth above.

Hazan does not teach the claimed VOC level. However, Hazan teaches that, "The amount of organic solvent added depends upon the desired solids level as well as the desired amount of VOC of the composition" (19:37-20:3). At the time of the invention a person of ordinary skill in the art would have found it obvious to have used the claimed amount of VOC, in order to meet environmental regulations.

Considering Claim 4: Hazan et al. teaches the basic claimed composition as set forth above. Additionally, Hazan teaches coloring and extender pigments (19:15-20).

Hazan does not teach the claimed pigment to binder ratio. However, Hazan teaches that, "It should be understood that the specific pigment to binder ratio can vary widely so long as it provides the requisite conductivity, barrier properties, color, and

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hiding at the desired film thickness and application solids" (19:19-21). At the time of the invention a person of ordinary skill in the art would have found it obvious to have used the claimed pigment to binder ratio, in order to achieve the requisite color of the article.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 11/332,064.

Although the conflicting claims are not identical, they are not patentably distinct from each other because although the copending claims do not claim a blocked polyisocyanate crosslinking agent, the instant claims do not require this crosslinking

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agent. The remaining limitations overlap to such an extent that the skilled artisan in practicing the copending claims would necessarily infringe the instant claims and vice versa.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH FRANK whose telephone number is (571)270-3667. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

NF
2-23-09